REMARKS

Reconsideration and allowance are respectfully requested. Claims 1 and 3-14 are currently pending, with Claims 1, 10 and 13 being independent. Claims 1-14 were rejected. In response, Claims 1, 4, 5, 10 and 12 have been amended and Claim 2 has been cancelled, with some of its subject matter incorporated into amended Claim 1. No new matter has been entered. Based on the following remarks, it is believed that all pending claims are in condition for allowance and a notice to that affect is respectfully requested.

I. §103(a) Rejection of Claims 1-4 and 6-11

Claims 1-4 and 6-11 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,101,477 to Hohle (hereafter referred to as Hohle '477) in combination with U.S. Patent No. 6,199,762 to Hohle (hereafter referred to as Hohle '762) and U.S. Patent No. 5,953,705 to Oneda. Based on the following remarks, Applicant respectfully traverses this rejection.

A. Amended Claim 1

According to amended Claim 1, the current invention is a method of booking access entitlement to a facility (i.e., a weekend pass to a ski resort), where a data carrier containing a microchip, such as a smart card, is used to gain access to the various areas of the resort. According to Claim 1, this is accomplished by several steps, including:

> determining a unique serial number that is coded upon the microchip within the data carrier as well as provided visibly on the data carrier;
>
> conveying the visible serial number, together with access entitlement data to be booked, via a telecommunication device to the access terminal and storing it there;

> acknowledging arrival at the facility by identifying the data carrier at the access terminal with the data communication device by electronically reading the serial number encoded upon the microchip and comparing the serial number coded therein with the stored serial number; and
>
> coding the previously booked access entitlement data onto the identified data carrier by the data communication device

(emphasis added).

B. Hohle '477 does not disclose conducting an off-line transaction by conveying a visibly read serial number and later comparing that visibly read serial number to the serial number electronically read from the card

In contrast to the claimed invention, Hohle '477 does not disclose a method of booking access to a facility by "determining a unique serial number that is coded upon the microchip ... as well as provided visibly on the data carrier", "conveying the visible serial number ... via a telecommunication device to the access terminal and storing it there", and then upon arrival at the facility, "electronically reading the serial number encoded upon the microchip and comparing the serial number coded therein with the stored serial number". Instead, Hohle discloses a travel-related smart card that must always be used in conjunction with one or more computer access points that connect to the Hotel.

According to Hohle '477, for a user to initiate a transaction, the user must insert smartcard 100 into a card reader at access point 15 upon which the user becomes properly authenticated. (See Hohle '477, 26:45-49 and 63-64) After authentication, the user has the option to make a hotel reservation. (See Hohle '477, 26:66-67) Once the reservation has been made, a confirmation number supplied by the hotel is downloaded into an electronic file stored within the

smartcard. (See Hohle '477, 27:13-16) At check-in, the smartcard is inserted into a card reader, the confirmation number is retrieved from the electronic file, and a room is subsequently assigned.

In contrast to Hohle '477, no confirmation number is downloaded to the data carrier or card of the claimed invention. The microchip serial number, which is visually read by the user during the process of booking access, is used only to identify the card/data carrier. No authentication of the card holder takes place.

The Office Action asserts that Hohle '477 discloses the ability to conduct offline transactions, citing two specific passages for support. However, a detailed review of these passages and the surrounding disclosure indicates that Hohle '477 does not disclose the offline booking of a service by determining a serial number provided visibly on the data carrier, conveying that visible serial number via a telecommunication device to an access terminal, and then upon arrival at the facility, electronically reading the serial number encoded upon the data carrier and comparing it to the serial number stored in the access terminal. Indeed, Hohle '477 does not disclose any type of offline transaction. Instead, Hohle '477 requires every transaction to be initiated by insertion of its smartcard into a card reader.

The Office Action cites two specific passages to support the assertion that Hohle '477 discloses the ability to conduct offline transactions. Each of these two sections will be reviewed separately below.

1. Col. 26, lines 59-61 of Hohle '477

This cited passage specifically states that "data may be sent later as part of a card/database synchronization procedure, e.g., when the original transaction proceeds off-line". However, taking the cited passage in context reveals

that Hohle '477 does not conduct an offline transaction by a user first conveying a serial number provided visibly on the card, and then upon arrival, electronically reading the serial number encoded in the card and comparing that serial number to the visibly provided serial number that was previously conveyed during the offline transaction.

Instead, this section of Hohle '477 specifies that a cardholder must first locate an access point (e.g., a stand-alone kiosk) and insert the card into the provided card reader in order to initiate a transaction. (See Hohle '477, 26:43-46) The user then places an order through the access point, where the data is then relayed over a network to the appropriate organization. (See Hohle '477, 26:53-59) If no network connection is present, Hohle then specifies that the transaction data can be "sent later as part of a card/database synchronization procedure". (See Hohle '477, 26:59-61)

Accordingly, although Hohle '477 discloses an "offline" transaction, it is seen that this transaction still requires a user to locate an access point and insert their card into a card reader, where all the required information is then electronically read from the card and then either conveyed over the network, or alternatively, stored and later conveyed by some form of synchronization procedure. As such, Hohle '477 does not disclose an "offline" transaction for purposes of the present invention because Hohle '477 always requires the card to first be electronically read by an access point. In contrast, the claimed invention conducts a true offline transaction that requires no access point, instead calling for a user to convey the serial number, provided visibly on the card, via a telecommunication device such as a telephone.

2. Col. 12, lines 38-52 of Hohle '477

The Office Action cites this specific passage as support that Hohle '477 discloses the ability to conduct "card not

present" transactions. However, a review of this passage in context reveals that Hohle '477 is not disclosing the ability to conduct smartcard "not present" transactions. Instead, Hohle '477 discloses a more typical transaction wherein a smartcard must be electronically read by an access point, but no separate credit card or debit card is also needed because the smartcard is programmed with the credit/debit card information required to carry out a financial transaction.

Specifically, Hohle '477 discloses that part of its smartcard internal programming includes a "payment card electronic file (EF) 510", which is "preferably used to catalog information related to the cardholder's various payment cards, i.e., debit cards, charge cards, and the like. In a particular preferred embodiment, payment card electronic files comprise card numbers and expiration dates for two cards." (See Hohle '477, 12:38-43)

By storing financial information on its smartcard, Hohle '477 is capable of conducting credit/debit card not present transactions. According to these types of transactions in Hohle '477, a smartcard must still be electronically read by an access point, but no separate charge/debit card is necessary because the required financial information needed to conduct a "payment card not present" transaction (e.g., the minimum information needed to conduct an online purchase, such as a credit card number and expiration date) is already stored in the smartcard. As such, this embodiment of Hohle '477 forgoes the need for a separate debit/charge card, but still requires that a smartcard be accessed by an access point in order to initiate a transaction.

C. Hohle '762 does not disclose conducting an off-line transaction by conveying a visibly read serial number and later comparing that visibly read serial number to the serial number electronically read from the card

The Office Action asserts that Hohle '762 discloses a method of booking entitlement similar to Hohle '477, but describes a "pending transaction" where the user calls a hotel to make a reservation using an interface such as voice or keypad over a standard telephone as a "smart card not present" transaction rather than an online transaction using the smart card. The information is stored in the hotel's database, and the smartcard is updated upon its next use in a smartcard transaction. (See Hohle '762, 14:38-15:5 and 8:13-25)

However, unlike the claimed invention, Hohle '762 does not disclose an offline transaction method whereby the serial number of the microchip is visibly provided on the smartcard, with the user conveying the visible serial number, along with the access entitlement data being booked, via a telecommunications device. Further, unlike the claimed invention, Hohle '762 does not disclose that upon arrival at the facility, the serial number encoded upon the microchip is electronically read and compared to the visually read serial number previously provided by the user and stored in the facility/hotel system.

In fact, Hohle '762 does not disclose the providing of any type of smartcard identifier (verses a user identity) during a "smart card not present" transaction. Absent any teaching, it appears that during Hohle's "smart card not present" transactions, the user (and thus the entire offline transaction) is simply identified by the actual identity or name of the person conducting the transaction, e.g., "This is John Doe, I would like to upgrade my reservation to a suite". Consequently, upon arrival at the hotel, the identity of the person must first be ascertained. Then the smartcard has to be associated with that person's identity before it can be updated with the most recent information. Consequently, Hohle's smartcard has no independent identity and cannot operate without a specific user. In contrast, the claimed

invention requires a user to visually read the microchip serial number of the smartcard and identify the offline transaction based on that serial number, not the user's identity. As such, the card has its own independent identity and can be operated without having to be associated with any specific user.

D. Oneda does not disclose conducting an off-line transaction by conveying a visibly read serial number and later comparing that visibly read serial number to the serial number electronically read from the card

The Office Action cites the reference of Oneda as disclosing an analogous art reservation method with an IC card that includes visible account information. Specifically, Oneda discloses a ticketless system for issuing airplane tickets, including an IC card 38 that includes an account number 306 and customer number 308 printed thereon, along with a LCD display 302 and a keypad 304 for inputting a user's identity/security code. (See Oneda, Figure 2B and 8:1-10)

According to Oneda, the IC card 38 is comparable to a bank debit card that can be used with an automatic teller machine (ATM). (See Oneda, 7:41-50) Oneda further specifies that the IC card is issued during a user's application to purchase an airline ticket. The user can subsequently take their IC card (now referred to as a distribution source card) and inserts it into a ticket issuing machine, where they can carry out various functions such as boarding reservations, ticket issue, check-in, seat assignments, etc. In addition, the user can transfer flight coupons to another user account registered in the reservation system. (See Oneda, 7:2-16)

However, as indicated by every example in the disclosure, Oneda always requires a user's IC card to be inserted into an access point (e.g., a "counter terminal apparatus" or "automatic ticket issuing machine") that is in communication

with the system's master database, before data can be read from the card and used to conduct transactions. Accordingly, Oneda does not disclose the conducting of any type of offline transaction.

Furthermore, Oneda neither discloses nor suggests using an account number 306 and/or customer number 308, let along a microchip serial number, printed upon the IC card in any transactions. The account number and customer number are never read by the user in order to conduct a transaction. Indeed, besides column 8, lines 6-7, the disclosure of Oneda never again mentions the account number 306 and customer number 308 printed upon the IC card. Similarly, Oneda never discloses visibly providing a serial number upon its IC card that corresponds to the unique serial number encoded within a microchip of the card. Accordingly, Oneda never discloses using a microchip serial number, provided in visible form on the data carrier or card, for identification of the IC card during an offline transaction whereby a user visually reads the serial number and conveys it together with access entitlement data to a remote database.

E. Summary with respect to Claim 1

Accordingly, as indicated in detail above, neither Hohle '477, Hohle '762 or Oneda disclose a method of booking access entitlement that includes the steps of "determining a unique serial number that is coded upon the microchip … as well as provided visibly on the data carrier", "conveying the visible serial number … via a telecommunication device to an access terminal and storing it there", and then upon arrival at the facility, "electronically reading the serial number encoded upon the microchip and comparing the serial number coded therein with the stored serial number".

Hohle '477 does not even disclose a method of conducting offline transaction without having to access its smartcard

using an access point. Hohle '762 discloses a simple offline transaction that fails to include the providing of any type of card identifier. Instead, Hohle '762, which is silent on the matter, presumably identifies all offline transactions based not on a card identity, but instead on a user identity (e.g., user name). As a result, even if either Hohle reference was provided with visually identifiable serial numbers on their cards, they would serve no purpose. Similar to the Hohle references, Oneda does not disclose the providing of a microchip serial number visibly on its card, although it does disclose providing an account and customer number on its card. However, Oneda subsequently fails to disclose using either visible account/customer number in the transaction process. Furthermore, Oneda does not even disclose the ability to conduct offline transactions.

For the above reasons, Applicant believes that independent Claim 1, along with dependent Claims 3-9, are allowable over the references of Hohle '477, Hohle '762, and Oneda, considered either individually or in combination.

F. Independent Claim 10

Similar to Claim 1, amended Claim 10 calls for a method of remotely booking access entitlement, including, among other things, the steps of:

> reading the serial number visibly marked on the portable data carrier;
>
> manually providing the serial number over the remote communication link to the computer server of the facility;
>
> storing the provided serial number and selected access entitlement on the computer server;
>
> identifying the portable data carrier upon arrival at the facility by electronically reading the serial number encoded on the

> microchip contained within the data carrier using an access terminal that communicates with the computer server; and
>
> retrieving the previously selected access entitlement associated with the provided serial number and stored in the computer server, and forwarding the selected access entitlement onto the access terminal

(emphasis added).

As previously discussed with respect to independent Claim 1, neither Hohle '477, Hohle '762, nor Oneda disclose visibly marking a portable data carrier with the unique serial number coded within the microchip of the data carrier, and subsequently conducting an off-line transaction by manually conveying the visibly read serial number over a remote communication link and later comparing that visibly read serial number, stored by the facility, to the serial number electronically read from the microchip contained with the data carrier. Accordingly, Applicant believes that independent Claim 10, and dependent Claims 11-12, are also allowable over the cited references.

II. §103(a) Rejection of dependent Claims 5 and 12

Dependent Claims 5 and 12 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hohle '477 in combination with Hohle '762 and Oneda and further in view of U.S. Patent No. 5,801,367 to Asplund. Based on the following remarks, Applicant respectfully traverses this rejection.

As previously discussed, neither Hohle '477, Hohle '762 nor Ondea conduct an off-line transaction by manually conveying the visibly read serial number of the data carrier's microchip over a remote communication link, and later comparing that visibly read serial number that was stored by the facility to the actual serial number electronically read from the microchip contained with the data carrier.

Similarly, Asplund also fails to disclose a data carrier having a microchip with a unique serial number where that serial number is visibly provide on the data carrier. As such, Asplund also fails to disclose the user having to visibly determine the unique serial number and subsequently convey that number as part of a remote booking procedure.

Asplund discloses a travel registration system that includes an electronic travel pass capable of storing a serial number individual to the card, as well as various user information and trip information. (See Asplund, 2:6-13 and 2:59-60) Incorporated into the travel pass is a biometric scanner (e.g, fingerprint scanner) and a LCD window capable of displaying certain information relating to a booked journey or route. (See Asplund, Figure 1 and 3:1-10) To first acquire a travel pass, a traveler must provide the booking agency with his or her pertinent contact information (e.g., data concerning the name, address and telephone number of the traveler), as well as conduct a biometric scan of their fingerprint. This information, along with a serial number of the electronic travel pass, is then stored in a database. (See Asplund, 4:7-30) Asplund further indicates that once a traveler is assigned a travel pass, he or she can book future trips over the telephone. Upon arrival at the facility (e.g., airport), the traveler inserts the pass into a data terminal that identifies the pass, queries the database and retrieves the travel information associated with that person, and then downloads the travel data to the pass. (See Asplund, 31-45)

However, unlike the claimed invention, Asplund does not disclose providing the serial number of its travel pass visibly on the pass. The travel pass does include a LCD display, but Asplund only discloses that the LCD display "data relating to a booked journey or route". (See Asplund, 5:4-9) Asplund never discloses that the LCD display the pass serial number. Futhermore, Asplund never teaches a method whereby

the traveler must first read the serial number of the pass and subsequently provide that serial number as part of the remote booking process.

For the above reasons, Applicant believes that dependent Claims 5 and 12 are allowable over the cited references.

III. §103(a) Rejection of dependent Claims 9

Dependent Claim 9 was rejected under 35 U.S.C. §103(a) as being unpatentable over Hohle '477 in combination with Hohle '762 and Oneda and further in view of U.S. Patent No. 4,573,046 to Pinnow. Based on the following remarks, Applicant respectfully traverses this rejection.

As previously discussed, neither Hohle '477, Hohle '762 nor Oneda conduct an off-line transaction by manually conveying the visibly read serial number of the data carrier's microchip over a remote communication link, and later comparing that visibly read serial number that was stored by the facility to the actual serial number electronically read from the microchip contained with the data carrier.

Pinnow is cited as disclosing a generic data carrier incorporated into a watch apparatus. However, similar to the previous references, Pinnow also fails to disclose the conducting of an off-line transaction by manually conveying the visibly read serial number of the data carrier's microchip over a remote communication link.

For the above reason, Applicant believes that dependent Claim 9 is allowable over the cited references.

IV. §103(a) Rejection of Claims 13 and 14

Claims 13 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hohle '477 in combination with Hohle '762 and Oneda and further in view of U.S. Patent No. 5,448,110 to Tuttle. Based on the following remarks, Applicant respectfully traverses this rejection.

According to independent Claim 13, the current invention is a method of remotely booking access entitlement to a facility (i.e., a weekend pass to a ski resort), which is accomplished by several steps, including:

> providing an identifier code that is unique to the smart card and which is visibly presented upon the smart card as well as encoded on the passive RFID transponder within the smart card;
>
> manually providing the identifier code over the remote communication link to the computer server of the facility;
>
> selecting a desired access entitlement and conveying the selection over the remote communication link to the computer server of the facility;
>
> storing upon the computer server the provided identifier code and selected access entitlement;
>
> identifying the smart card being presented by a user upon arrival at the facility by electronically reading the identifier code that is encoded on the passive RFID transponder using an access terminal that communicates with the computer server; and
>
> retrieving the previously selected access entitlement associated with the provided identifier code and stored in the computer server, and forwarding the selected access entitlement onto the access terminal; and
>
> encoding the associated access entitlement onto the passive RFID transponder using the access terminal

(emphasis added).

Similar to the reasons previously discussed with respect to independent Claims 1 and 10, neither Hohle '477, Hohle '762 nor Oneda conduct an off-line transaction by manually conveying a visibly read identifier code of the smart card over a remote communication link, subsequently electronically reading the identifier code encoded on the RFID transponder incorporated into the smart card, and then retrieving the

previously selected access entitlement associated with the visually read identifier code.

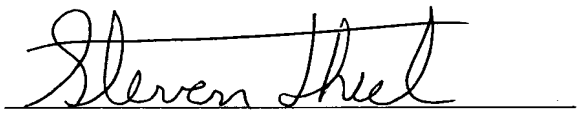
Tuttle, which is merely cited for its disclosure concerning a passive RFID tag/transponder, fails to cure the above-noted deficiencies of Hohle '477, Hohle '762 and Oneda.

Accordingly, for reasons similar to those presented above with respect to Claims 1 and 10, Applicant believes that independent Claim 13 and dependent Claim 14 are also allowable over the cited prior art.

V. Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance, and a Notice to that effect is earnestly solicited.

Respectfully submitted,



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Encl: Post Card

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